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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,447	09/29/1999	TSUKASA SAKO	862.3050	4061

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,447

Applicant(s)

SAKO ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-79,94-97,106 and 109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-79,94-97,106 and 109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to:
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on May 24, 2004 has been entered and made of record.
2. Applicant's arguments have been fully considered, and are addressed in the prior art rejections below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 76-77, 94-95, 106, 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al., U.S. Patent No. 5,774,232 ("Tabata").

Referring to claim 76, Tabata discloses an image outputting system for outputting image data to an output medium, the system comprising:

- a. designation means for designating an outputting area in image data obtained by computerizing an input image to be outputted to an output medium, based on a scanned portion of the image (col. 16, lines 9-10 and col. 16, line 62-col. 17, line 8. Note that the "read image" in col. 16, line 67-col. 17, line 1 is interpreted as the "outputting area")

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b. selection means for selecting one of a plurality of output medium sizes (col. 16, lines 62-67. Note that an output medium size is selected before it is fed into the document feeding means)--

c. determination means for determining an output mode based on a relationship between the designated outputting area and the output medium size selected by the selection means (col. 16, line 62-col. 17, line 8).

Tabata explains that the outputting area is designated based on a scanned portion of the image (as noted above), but does not explicitly disclose that it is based on a photographed portion of the image. However, the Examiner notes that Tabata's scanned image and a photographed image are both considered image data. Furthermore, Official notice is taken that a photographed image data was exceedingly well known and commonly used in the art. Therefore, since Tabata is concerned with obtaining image data, it would have been obvious to modify the scanned image of Tabata so that it is a photographed image. The suggestion/motivation for doing so would have been to increase the flexibility of the system.

Referring to claim 77, Tabata further discloses that the determination means determines an output mode based on whether or not the outputting area falls within an effective image area of the selected output medium size (col. 16, line 62-col. 17, line 8).

Referring to claim 94, see the rejection of at least claim 76 above.

Referring to claim 95, see the rejection of at least claim 77 above.

Referring to claims 106 and 109, see the rejection of at least claim 76 above. Tabata further discloses a means for imaging an object (document) and obtaining image data representing the object image (col. 16, lines 9-13), but fails to explicitly disclose a photographing

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means for photographing the object. However, the Examiner notes that Tabata's imaging means and a photographing means are both used to produce image data. Furthermore, Official notice is taken that a photographing means for photographing an object was exceedingly well known and commonly used in the art. Therefore, since Tabata is concerned with obtaining image data, it would have been obvious to modify the imaging means of Tabata so that it is a photographing means for photographing an object. The suggestion/motivation for doing so would have been to increase the flexibility of the system.

4. Claims 78-79, 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tabata et al., U.S. Patent No. 5,774,232 ("Tabata") and Endo et al., U.S. Patent No. 6,335,796 ("Endo").

Referring to claim 78, Tabata further discloses that the determination means includes a segmenting output mode where an outputting area is segmented into a plurality of segmentation areas and outputted to a plurality of output media (col. 16, line 62-col. 17, line 8).

Tabata fails to disclose that the determination means includes a life-size output mode, a reduced image output mode, and an extraction output mode. However, these features were exceedingly well known in the art. For example, Endo discloses an output determination means that includes a life-size output mode wherein an entire outputting area is outputted in an actual size (col. 10, lines 63-65), a reduction image output mode where an outputting area is reduced and then outputted (col. 11, lines 8-10), and an extraction output mode where a predetermined area is extracted from an outputting area and then outputted (col. 11, lines 2-8. Note that the "area of concern" in line 7 extracts a predetermined area such as the lung area to be output.).

Tabata and Endo are both concerned with outputting an image on different output medium sizes. Endo's system reduces troublesome procedures on the part of the operator, thereby allowing the outputting to be performed optimally under various conditions (Endo, col. 12, lines 18-23). Therefore, it would have been obvious to modify the determination means of Tabata, to include a life-size output mode, a reduced image output mode, and an extraction output mode, as taught by Endo, in order to enhance the output process.

Referring to claim 79, Endo further discloses that the determination means settles the output mode to one of the reduced image output mode, when an output medium size selected by a selection means is not appropriate for the life-size output mode (col. 11, lines 20-33).

Referring to claim 96, see the rejection of at least claim 78 above.

Referring to claim 97, see the rejection of at least claim 79 above.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ck

July 28, 2004


Jon Chang
Primary Examiner